

REMARKS

The applicants respectfully request reconsideration in view of the amendment and the following remarks. The applicants have amended claims 21 and 27 as suggested by the Examiner. In addition, support for amended claim 21 can be found in the specification at page 15, lines 10-15. Support for newly amended claims 25 and 26 can be found in claims 25 and 26. The applicants have enclosed a drawing as requested by the Examiner. The drawing is supported at page 15, lines 12-15 of the specification.

Claims 21-31 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 21-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Moses U.S. Patent No. 5,237,582 ("Moses") in view of Lupo et al. EP 067646 ("Lupo"). The applicants respectfully traverse these rejections.

The applicants have amended the claims as suggested by the Examiner. The Examiner stated, "it seems the light source exciting the laser dye and the presence of the electrode layers seems unnecessary." The applicants have deleted these terms. The applicants revisited the prosecution of the application and point out that the applicants argued the criticality of the laser over references Furuki (US 5,568,417) and Crivello (US 4,026,705) (see the Amendment mailed December 2, 2002 ("AMENDMENT")). At page 16 of the AMENDMENT, the applicants argued that the prior art did not disclose a laser. The applicants further argued in the second to last paragraph at page 16 of the AMENDMENT that the claims require a laser and a light source. Furthermore at page 18 of the AMENDMENT the applicants again argued that three of the prior art references did not teach a laser and again the applicants refer to the laser source as being a

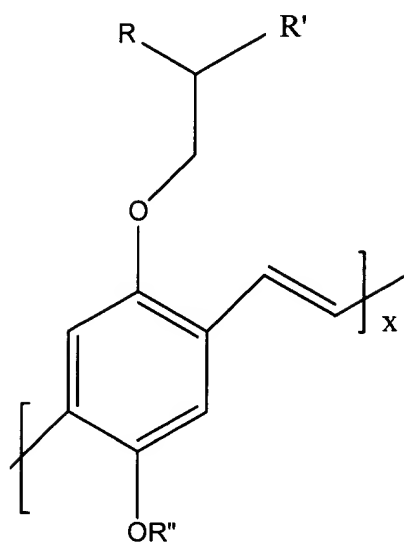
feature not taught by the prior art. Upon review of the previously applied prior art, the applicants do not believe that claims need to be limited to requiring a light source.

35 U.S.C. §112, Second Paragraph Rejection

Claims 21-31 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicants have amended the claims as suggested by the Examiner and believe that the claims as amended are in compliance with 35 U.S.C. §112, second paragraph.

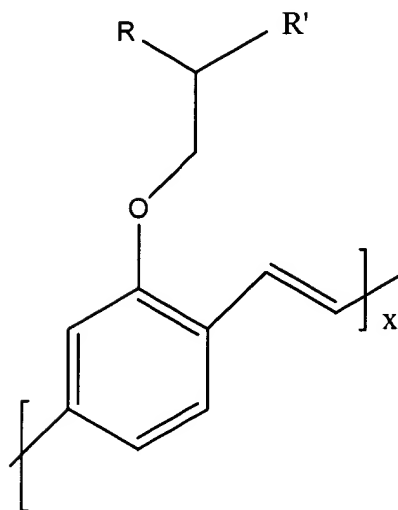
35 U.S.C. §103 Rejection

Claims 21-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Moses in view of Lupo. The Examiner correctly stated that Moses lacks the spiro dye of formula (1). However, Moses teaches a specific dye of having the following chemical formulas:



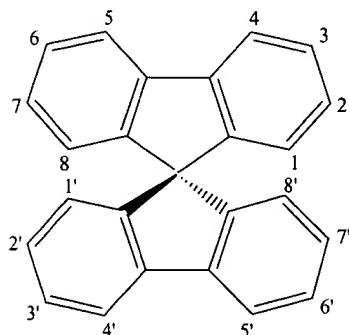
MEH-PPV

or



EH-PPV

These formulas are not remotely related to the applicants' claimed spiro dye.



(II)

There is no suggestion or teaching in Moses to use any other dye then the two dyes described above.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters **without any direction** as to the particular one selection of the reference **without**

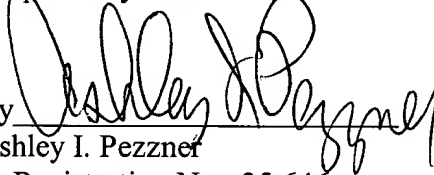
proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** is suggested by the prior art (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469,473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Moses and Lupo.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

A two month extension fee has been paid. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 09931-00009-US from which the undersigned is authorized to draw.

Respectfully submitted,

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